

REMARKS

The applicant respectfully requests reconsideration in view of the amendment and the following remarks. The applicant has incorporated claim 21 into claim 11. Support for newly added claim 27 can be found in claim 26. The amendment raises no new issues. The applicant has cancelled two claims and added one claim. No fee is required for the extra claim added.

Comments to Interview

The applicant appreciates the Examiner permitting the applicant to interview the application on March 19, 2009. The applicant discussed the differences between the prior art and the claimed invention. The applicant also discussed the showing presented in the application. The Examiner suggested an additional showing.

Claims 11-22, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandenhende et al., US 2003/0119925 (“Vandenhende”). Claims 11 and 26 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Vandenhende in view of US 4,146,499 (Rosano). The applicant respectfully traverses these rejections.

Rejections under 35 U.S.C. 103(a)

Claims 11-22, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandenhende. Claims 11 and 26 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Vandenhende in view of Rosano.

As the Examiner has correctly recognized at page 2 of the Final Office Action, Vandenhende teaches to use a (one) dispersing agent and does not even merely suggest using 2

different ones. In paragraph no. [0025], lines 2-3 of Vandenhende states, “it is advantageous for this precipitation to take place in the presence of a dispersing agent”.

Furthermore, Vandenhende recites, in the same paragraph, lines 4-10, characterizes the dispersing agent (in the singular), “this is advantageously added to the solvent from the beginning of the dissolution of the plastic. Alternatively, this dispersing agent may be added at the same time as the non-solvent used for the precipitation.

Finally, lines 11-4 of the same paragraph recites that “the term dispersing agent should be understood to mean surfactants, such as bentonite, polyvinyl alcohol, gelatin, esters or ethers of cellulose, water-soluble (co)-polymers, etc ..” and that “Ethers of cellulose give good results”.

There is no more information in Vandenhende about the use of dispersing agent, neither in the text of the specification nor in the examples. The applicant has two independent claims (claims 11 and 26).

CLAIM 11

Claim 11 is limited by the feature that

- the precipitation takes place in a precipitation medium comprising two dispersants;
- one with a greater affinity for the non-solvent (dispersant (I)) and
- the other with a greater affinity with the solvent (dispersant (II));
- those two dispersants are polyvinyl alcohols having different degrees of hydrolysis;
- one of which (dispersant (I)) has a degree of hydrolysis (DH) of 65 to 90%; and
- the other (dispersant (II)) has a degree of hydrolysis (DH) less than or equal to 60%.

Therefore, compared with the teaching of Vandenhende, disclosing the use of one dispersing agent and listing several families among which this dispersing agent may be chosen

with a preference for ethers of cellulose, the object of the applicant's claim 11 is limited by the six characteristics which are underlined above.

A statement that modifications of the prior art to meet the claimed invention would have been "obvious to one of ordinary skill in the art at the time the invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See MPEP § 2143.01 IV. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Furthermore, the Examiner cannot selectively pick and choose from the disclosed parameters without proper motivation as to a particular selection. The mere fact that a reference may be modified to reflect features of the claimed invention does not make the modification, and hence the claimed invention, obvious unless the prior art suggested the desirability of such modification. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990); *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). Thus, it is impermissible to simply engage in a hindsight reconstruction of the claimed invention where the reference itself provides no teaching as to why the applicant's combination would have been obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). For the above reasons, this rejection should be withdrawn.

Assuming arguendo that the Examiner has made a *prima facie* case of obviousness, the applicant believes that they have rebutted it, by comparing the results of example 4 and comparative example R1. The Examiner is of the opinion that the results presented in the

examples do not support the fact that it is when two dispersants are used that unexpected results are obtained. The Examiner is also of the opinion that it is not demonstrated that the unexpected results are not due to the total quantity of the dispersants which is higher in example 4 than in comparative example R1 (see page 7 of the Office Action).

The applicant believes that this argumentation is wrong when comparing other data available in the same table. Indeed, the ratio ASG/d which are obtained for examples 5, 6, 7 and 8 are clearly different while each of those examples involves the use of exactly the same total quantity of dispersants i.e. 0.6 weight %. Furthermore, the ASG/d ratio obtained for all those four examples is higher than the one obtained for comparative examples R1 and R2 involving the use of only one dispersant.

Additionally, comparing the ASG/d ratio obtained for example 4 (i.e. 1.67) with the one obtained for example 5 (i.e. 1.64), it can be noted that the ASG/d ratio is nearly the same, even slightly lower for example 5, while the total quantity of the two dispersants is lower (i.e. 0.4) in example 4 than in example 5 (i.e. 0.6), in fact 0.2 % lower in example 4. And again, the ASG/d ratio obtained for those two examples 4 and 5, involving the use of two dispersants, is higher than the one obtained for comparative examples R1 and R2 involving the use of only one dispersant.

These comparisons clearly demonstrate that this is not when the total quantity of the two dispersants is higher, that the ASG/d result is higher and that this total quantity does not influence the ASO/d result.

Furthermore, the applicant respectfully disagrees with the Examiner when she states that the data actually showed unexpected results and that the applicant's claim 11 is too broad compared to what is demonstrated in the examples.

Indeed, the data presented in the examples according to the invention relate to the use of

two dispersants which are polyvinyl alcohols (Poval[®]L9 which is dispersant (I) with a greater affinity for the non-solvent and Poval[®]LM10HD which is dispersant (II) with a greater affinity for the solvent) having different DH (71% pour dispersant (I) and 40% for dispersant (II)) in the ranges specified in Claim 11. Therefore, the six characteristics limiting Claim 11 are fulfilled in the examples. The applicant believes that the claims are commensurate in scope with the showing.

For those reasons, this rejection should be withdrawn.

CLAIM 26 (second independent claim)

As the dispersant is concerned, Claim 26 is limited by the fact that

- the precipitation takes place in a precipitation medium comprising two dispersants;
- one with a greater affinity for the non-solvent (dispersant (I) and
- the other with a greater affinity with the solvent (dispersant (II); and
- dispersant (I) is primarily added to the precipitation medium before the phase inversion and
- dispersant (II) is primarily added to the precipitation medium after the phase inversion.

Therefore, compared with the teaching of Vandenhende disclosing the use of one dispersing agent which may be added at the same time as the non-solvent, the object of Claim 26 is limited by the five characteristics which are underlined above. For the above reasons, this rejection should be withdrawn.

Assuming arguendo that the Examiner has made a prima facie case of obviousness, the applicant believes that the data in the specification rebuts this rejection. Comparing the results

of examples 6, 7 and 8 with the results of (comparative examples R1 and R2), all of them involving the treatment of 11 weight % PVC suspension, it can be shown that the ASG/d ratio is higher for examples 6, 7 and 8 than the one obtained for the comparative examples.

Furthermore, considering the total quantity of the two dispersants which are used, it can be noted that examples 6, 7 and 8 for which the total quantity of the two dispersants is 0.6 weight %, lead to a higher ASG/D ratio than example 5 characterized by the same total quantity of the two dispersants. Again, this comparison clearly demonstrates that the total quantity of the two dispersants does not influence the ASO/d result.

Furthermore, the applicant does not agree with the Examiner when she states that the data actually showed unexpected results and that applicant's claim 26 is too broad compared to what is demonstrated in the examples.

Indeed, the data presented in examples 6, 7 and 8 which are the examples according to the invention relate to the use of two dispersants, one with a greater affinity for the non-solvent (dispersant (I) and the other with a greater affinity with the solvent (dispersant (II); and dispersant (I) is primarily added to the precipitation medium before the phase inversion and dispersant (II) is primarily added to the precipitation medium after the phase inversion. So the five characteristics limiting Claim 26 are fulfilled. For the above reasons, this rejection should be withdrawn.

A two month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05129-00117-US from which the undersigned is authorized to draw.

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Respectfully submitted,

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